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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/146,069	09/02/1998	TAKEHIRO YOSHIDA	1232-4467	6726

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MORGAN & FINNEGAN
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NEW YORK, NY 10154

EXAMINER

POKRZYWA, JOSEPH R

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 07/15/2003

24

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/146,069

Applicant(s)

YOSHIDA, TAKEHIRO

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 21, 2003 has been entered.

Response to Amendment

2. Applicant's amendment was received on April 21, 2003, and has been entered and made of record. Currently, **claims 1-25** are pending.

Response to Arguments

3. Applicant's arguments with respect to **claims 1-25** have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. **Claims 1, 2, 4-7, 9-13, 15, 18-25** are rejected under 35 U.S.C. 102(e) as being anticipated by Ishibashi *et al.* (U.S. Patent Number 6,374,291).

Regarding **claim 1**, Ishibashi discloses a communication apparatus (see Figs. 1 and 2) comprising a means for sending a facsimile to a recipient through the Internet by dial-up connection (see abstract, and column 7, lines 11 through 25, being steps S9-S13 in Fig. 6), and means for notifying the recipient using a PSTN (being inherent in the standard analog telephone lines L2, using a circuit switching method, as read in the abstract) that the facsimile has been sent to the recipient through the Internet (column 7, lines 34 through 55, see “(a) Third Party Table T1” in Fig. 3, and see Fig. 11), prior to the recipient accessing the Internet (see abstract and Fig. 11, and column 9, line 12 through column 10, line 14).

Regarding *claims 2 and 10*, Ishibashi discloses a communication apparatus (see Figs. 1 and 2) and a control method for the communication apparatus comprising means for performing facsimile communication through the Internet by dial-up connection (see abstract, and column 7, lines 11 through 25, being steps S9-S13 in Fig. 6), and means for, in response to a notification, from a calling party communication apparatus using a PSTN (being inherent in the standard analog telephone lines L2, using a circuit switching method, as read in the abstract), that the calling party communication apparatus has sent a facsimile to the communication apparatus through the Internet (column 7, lines 34 through 55, see “(a) Third Party Table T1” in Fig. 3, and see Fig. 11), setting up connection to the Internet by dial-up connection and receiving facsimile communication information through the Internet by Post Office Protocol (column 5, lines 39 through 54, and column 9, line 14 through column 10, line 38).

Regarding *claim 4*, Ishibashi discloses the apparatus discussed above in claim 2, and further teaches of a means for registering a time of execution of POP processing on the basis of a user operation (column 9, line 50 through column 10, line 14).

Regarding *claims 5 and 11*, Ishibashi discloses a communication apparatus (see Figs. 1 and 2) and control method capable of facsimile communication through the Internet by dial-up connection (see abstract, and column 7, lines 11 through 25, being steps S9-S13 in Fig. 6), comprising a means for, in response to a notification, from a calling party communication apparatus using a PSTN (being inherent in the standard analog telephone lines L2, using a circuit switching method, as read in the abstract) that the calling party communication apparatus has sent a facsimile to the communication apparatus through the Internet (column 7, lines 34 through 55, see “(a) Third Party Table T1” in Fig. 3, and see Fig. 11), displaying information

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representing that the calling party communication apparatus has sent a facsimile to the communication apparatus through the Internet and station address information of a calling party (see Fig. 11, and column 9, lines 14 through column 10, line 38), means for determining on the basis of selection by a user whether the communication apparatus is to set up connection to the Internet by dial-up connection (column 10, lines 9 through 14) to receive facsimile communication information through the Internet by Post Office Protocol (column 5, lines 39 through 54, and column 9, line 14 through column 10, line 38).

Regarding *claim 6*, Ishibashi discloses the apparatus discussed above in claim 5, and further teaches of a means for registering whether, in response to the notification, dial-up connection is to be immediately performed on the basis of the station address of the calling party communication apparatus to receive the facsimile communication information through the Internet by POP (column 9, line 50 through column 10, line 14).

Regarding *claim 7*, Ishibashi discloses the apparatus discussed above in claim 5, and further teaches that when dial-up connection is performed to receive the facsimile communication information through the Internet, all pieces of facsimile communication information received by a service provider are received (column 9, line 13 through column 10, line 18).

Regarding *claim 9*, Ishibashi discloses a communication method comprising a step of performing facsimile communication through the Internet by dial-up connection (see abstract, and column 7, lines 11 through 25, being steps S9-S13 in Fig. 6), and a step of notifying a recipient using a PSTN (being inherent in the standard analog telephone lines L2, using a circuit switching method, as read in the abstract) that a facsimile has been sent through the Internet

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(column 7, lines 34 through 55, see “(a) Third Party Table T1” in Fig. 3, and see Fig. 11), prior to the recipient accessing the Internet (see abstract and Fig. 11, and column 9, line 12 through column 10, line 14).

Regarding *claims 12, 18, and 19*, Ishibashi discloses a communication apparatus (see Figs. 1 and 2), having a control method, and a computer-readable storage medium (ROM 6), which stores a program for controlling the communication apparatus (column 3, lines 46 through 54), capable of facsimile communication through the Internet by dial-up connection (see abstract, and column 7, lines 11 through 25, being steps S9-S13 in Fig. 6), comprising means for establishing a dial-up connection from a station A to an Internet service provider to execute communication with a station B (see abstract, Fig 3, and column 7, lines 11 through 60, being steps S9-S13 in Fig. 6) having a TCP/IP address through the Internet (column 5, lines 28 through 60), and means for calling the station B from the station A, when the dial-up connection is established, notifying the station B via the PSTN (being inherent in the standard analog telephone lines L2, using a circuit switching method, as read in the abstract) that a facsimile has been sent through the Internet and description transmitted through the Internet (column 7, lines 34 through 55, see “(a) Third Party Table T1” in Fig. 3, and see Fig. 11), prior to station B accessing the Internet (see abstract and Fig. 11, and column 9, line 12 through column 10, line 14).

Regarding *claim 13*, Ishibashi discloses the apparatus discussed above in claim 12, and further teaches that the description information is summarized text representing a summary of facsimile communication (see Fig. 11).

Regarding *claim 15*, Ishibashi discloses the apparatus discussed above in claim 12, and further teaches of transmitting a number of pages of facsimile information transmitted through the Internet and a communication time (see Fig. 11).

Regarding *claim 20*, Ishibashi discloses a communication apparatus (see Figs. 1 and 2) comprising means for transmitting facsimile data via the Internet (see abstract, column 6, line 35 through column 7, line 25), and means for notifying a recipient, by a method different from that of the transmission means (see abstract, column 7, lines 26 through 55, and Fig. 11), that the transmission means has already sent the facsimile data to the recipient via the Internet (column 7, lines 34 through 55, see “(a) Third Party Table T1” in Fig. 3, and see Fig. 11), prior to the recipient accessing the Internet (see abstract and Fig. 11, and column 9, line 12 through column 10, line 14).

Regarding *claim 21*, Ishibashi discloses the apparatus discussed above in claim 20, and further teaches that the transmission means transmits the data through the Internet (see abstract, and column 7, lines 11 through 19), and the notification means transmits notification through a public telephone network (being inherent in the standard analog telephone lines L2, using a circuit switching method, as read in the abstract).

Regarding *claim 22*, Ishibashi discloses a communication apparatus (see Figs. 1 and 2) comprising first means for sending facsimile data over a first communication network (being the Internet, see abstract) to a recipient (see abstract, and column 7, lines 11 through 19), second means for sending data over a second communication network (analog line L2) to the recipient (see abstract, column 7, lines 26 through 55, and Fig. 11), and third means (CPU 1) for controlling the first means and the second means (column 3, lines 29 through 33), wherein the

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third means controls the second means so as to send data (see Fig. 11) corresponding to the sending operation of the first means (see abstract, column 7, lines 26 through 55), and wherein the sending operation of the second means indicates that the first means has already sent the facsimile data over the first communication network to the recipient (column 7, lines 34 through 55, see “(a) Third Party Table T1” in Fig. 3, and see Fig. 11), prior to the recipient accessing the second communication network (see abstract and Fig. 11, and column 9, line 12 through column 10, line 14).

Regarding *claim 23*, Ishibashi discloses the apparatus discussed above in claim 22, and further teaches that the first communication network (Internet) is a facsimile communication network (see abstract).

Regarding *claim 24*, Ishibashi discloses the apparatus discussed above in claim 22, and further teaches that the second communication network is a telephone network (being inherent in the standard analog telephone lines L2, using a circuit switching method, as read in the abstract).

Regarding *claim 25*, Ishibashi discloses the apparatus discussed above in claim 22, and further teaches that the data sent by the second means is a part of data sent by the first means (see Fig. 11).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 3 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishibashi *et al.* (U.S. Patent Number 6,374,291) in view of Picard *et al.* (U.S. Patent Number 6,233,318, cited in the Office action dated 11/19/02).

Regarding **claim 3**, Ishibashi discloses the system discussed above in claim 1, but fails to specifically teach of a means for selecting on the basis of a user operation whether the communication is an important communication, and wherein when the important communication is not selected, the notification means do not notify using a PSTN that the facsimile is being sent through the Internet. Picard discloses a communication apparatus (integrated messaging system 106) and method comprising a means for performing facsimile communication through the Internet by dial-up connection (column 6, lines 29 through 34, and column 9, lines 11 through 46), and means for notifying a recipient using a PSTN (104) that a facsimile has been sent through the Internet (column 11, lines 43 through 59), prior to the recipient accessing the Internet (column 9, line 40 through column 10, line 6). Further, Picard teaches of a means for selecting on the basis of a user operation whether the communication is an important communication (column 6, line 48 through column 7, line 19), and wherein when the important communication is not selected, the notification means do not notify using a PSTN that the facsimile is being sent through the Internet (column 11, line 43 through column 12, line 28). Therefore, it would have

been obvious to a person of ordinary skill in the art at the time the invention was made to include Picard's teachings in the system of Ishibashi. Ishibashi's system would easily be modified with the teachings of Picard, as the systems share cumulative features, being additive in nature.

Regarding *claim 8*, Ishibashi discloses the apparatus discussed above in claim 5, and further teaches of a display means for displaying communication management information (column 3, lines 40 through 46), but fails to particularly teach of, in response to the notification, displaying a list of communication management information independently of communication management information associated with normal transmission/reception, and displaying whether reception of the facsimile communication information from the service provider is complete. Picard discloses a communication apparatus (integrated messaging system 106) and control method capable of facsimile communication through the Internet by dial-up connection (column 6, lines 29 through 34, and column 9, lines 11 through 46), comprising a means for, in response to a notification, from a calling party communication apparatus (column 7, line 29 through column 8, line 9) using a PSTN (104) that the calling party communication apparatus has sent a facsimile to the communication apparatus through the Internet (column 11, lines 37 through 65), displaying information representing that the calling party communication apparatus has sent a facsimile to the communication apparatus through the Internet and station address information of a calling party (column 7, line 13 through column 8, line 9), means for determining on the basis of selection by a user whether the communication apparatus is to set up connection to the Internet by dial-up connection (column 11, lines 37 through 65) to receive facsimile communication information through the Internet by Post Office Protocol (column 12, lines 11 through 33). Further, Picard teaches of display means for, in response to the notification (column

11, lines 37 through 50), displaying a list of communication management information independently of communication management information associated with normal transmission/reception (column 7, lines 13 through 28), and displaying whether reception of the facsimile communication information from the service provider is complete (column 6, line 35 through column 7, line 40). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Picard's teachings in the system of Ishibashi. Ishibashi's system would easily be modified with the teachings of Picard, as the systems share cumulative features, being additive in nature.

8. **Claims 14 and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishibashi *et al.* (U.S. Patent Number 6,374,291) in view of Bobo, II (U.S. Patent Number 5,675,507, cited in the Office action dated 11/19/02).

Regarding **claim 14**, Ishibashi discloses the apparatus discussed above in claim 12, but fail to specifically teach if the description information is information of a first page of facsimile information transmitted through the Internet. Bobo discloses a communication apparatus capable of facsimile communication through the Internet by dial-up connection (see Fig. 1), comprising means for performing dial-up connection from a station A (facsimile 24) to an Internet service provider (column 6, lines 44 through 56) to execute communication with a station B (personal computer 32), and means for, when communication by the communication execution means has been executed (process of Fig. 2), calling the station B (step 56, column 7, lines 6 through 8) to transmit information representing that facsimile communication has been executed and description information of the facsimile communication executed through the Internet (column 8,

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line 22 through column 9, line 37). Further, Bobo teaches that the description information is information of a first page of facsimile information transmitted through the Internet (column 9, lines 2 through 17). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bobo's teachings in Ishibashi's system. Ishibashi's system would become more user-friendly if adapted to incorporate Bobo's teachings, as the user would be able to quickly scroll through cover pages of transmitted messages, without downloading the entire message.

Regarding *claim 16*, Ishibashi discloses the apparatus discussed above in claim 12, but fail to specifically teach of a means for selecting, as the description information to be transmitted, either summarized text representing a summary of facsimile communication or information of a first page of facsimile information transmitted through the Internet. Bobo discloses a communication apparatus capable of facsimile communication through the Internet by dial-up connection (see Fig. 1), comprising means for performing dial-up connection from a station A (facsimile 24) to an Internet service provider (column 6, lines 44 through 56) to execute communication with a station B (personal computer 32), and means for, when communication by the communication execution means has been executed (process of Fig. 2), calling the station B (step 56, column 7, lines 6 through 8) to transmit information representing that facsimile communication has been executed and description information of the facsimile communication executed through the Internet (column 8, line 22 through column 9, line 37).

Further, Bobo teaches of a means for selecting, as the description information to be transmitted, either summarized text representing a summary of facsimile communication (column 8, lines 53 through 63) or information of a first page of facsimile information transmitted through the

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Internet (column 9, lines 2 through 30). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bobo's teachings in Ishibashi's system. Ishibashi's system would become more user-friendly if adapted to incorporate Bobo's teachings, as the user would be able to determine display options, without downloading the entire message.

9. **Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishibashi *et al.* (U.S. Patent Number 6,374,291) in view of Wegner *et al.* (U.S. Patent Number 5,712,907, cited in the Office action dated 11/19/02).

Regarding *claim 17*, Ishibashi discloses the apparatus discussed above in claim 12, and further teaches of a means for transmitting the facsimile information from the station A to the station B through the general public network without performing communication by the Internet communication execution means (column 9, line 13 through column 10, line 14). However, Ishibashi fails to teach of transmitting the facsimile information through the general public network when the number of pages of the facsimile information to be transmitted from the station A to the station B through the Internet is not more than a predetermined value. Wegner discloses a communication apparatus capable of facsimile communication through the Internet by dial-up connection (column 4, lines 7 through 11), comprising means for performing dial-up connection from a station A (message communicating device 2s) to an Internet service provider (network node 6s) to execute communication with a station B (message communicating devices 1r, 2r, or 3r) having a TCP/IP address through the Internet (column 8, lines 31 and 32, and column 13, line 64 through column 14, line 3), and means for, when communication by the

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Internet communication execution means has been executed, calling the station B (recipient 8r in Fig. 7a) using a general public network (PSTN 5) to transmit information representing that facsimile communication has been executed through the Internet and description information of the facsimile communication executed through the Internet (column 3, lines 52 and 53). Further, Wegner teaches of a means (least cost routing processor 103) for, when the number of pages of the facsimile information to be transmitted from the station A to the station B through the Internet is not more than a predetermined value (column 10, lines 21 through 23, and column 12, lines 59 through 62, wherein the number of pages of the message corresponds to the size of the message), transmitting the facsimile information from the station A to the station B through the general public network (PSTN 5) without performing communication by the Internet communication execution means (column 3, lines 54 65, and column 7, lines 25 through 62).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Wegner's teachings in Ishibashi's system, thereby having a means for transmitting the facsimile information from the station A to the station B through the general public network without performing communication by the Internet communication execution means when the number of pages of the facsimile information to be transmitted from the station A to the station B through the Internet is not more than a predetermined value. Ishibashi's system would become more efficient if adapted to incorporate Wegner's teachings, as the most cost effective transmission would be selected to route the facsimile message.

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Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

J.R.P.

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrj
July 3, 2003


EDWARD COLES

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